

Appl. No.: 10/767,534  
Submission Pursuant to 37 C.F.R. §1.114(c)  
Group Art Unit: 1755

### **Remarks**

The foregoing amendments and following remarks are responsive to the July 12, 2006 Final Office Action and November 22, 2006 Advisory Action. Reconsideration is respectfully requested.

### **Status of the Claims**

Claims 1, 22 and 35 are amended. Claims 33 and 34 are cancelled. Claim 44 was cancelled previously. Claims 1-32 and 35-43 are pending.

### **Support for Amendments**

Claims 1 and 22 are amended to clarify the invention. Claim 33 is cancelled, rendering the objection under 37 C.F.R. 1.75(c) moot. Claim 35 is amended to change dependency and include an additional mole ratio. Support for the amendments is found throughout the specification, and particularly on page 1, lines 18-20, page 3, lines 3-8, pages 8-13, and the Examples. No new matter is added.

### **Rejections under 35 U.S.C. § 102(b)**

Claims 1-3, 6-24 and 26-41 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,827,453 (Gross). Claims 1-20 and 22-40 were rejected under 35 U.S.C. § 102(a) or (e) as being anticipated by U.S. Patent No. 6,350,787 (Wiggins). Claim 1 (from which Claims 2-3, 6-21, 31-32 and 35-41 depend) and Claim 22 (from which Claims 23-24 and 26-30 depend) are amended to clarify the invention. Claims 33 and 34 are cancelled, rendering the rejection moot as to those claims.

Gross relates to defoaming compositions for aqueous surfactant systems. The non-aqueous reaction products of Gross are added to an aqueous surfactant composition to reduce or eliminate foam. Example 1 (cited by the Examiner) illustrates

the non-aqueous reaction product added to an aqueous system. Although Gross discloses a non-aqueous composition, the composition is in an aqueous system, whereas the invention of Claims 1-3, 6-24, 26-32 and 35-41 relates to a non-aqueous composition in a non-aqueous system, formulated to be applied to a substrate by spray application with an effective foam-reducing quantity of the reaction product.

For a reference to anticipate, each element of the claim must be present. Since Gross fails to disclose the non-aqueous composition in a non-aqueous system with an effective foam-reducing quantity of the reaction product, Gross does not anticipate the subject matter of the above claims, and the rejection should be withdrawn. Reconsideration and withdrawal of the rejection is respectfully requested.

Wiggins relates to defoamers for aqueous systems. The reaction products of Wiggins are added to aqueous systems, for example, latexes and latex paint. Example 7 (cited by the Examiner) illustrates the non-aqueous reaction product added to an aqueous system. Although Wiggins discloses a non-aqueous composition, the composition is in an aqueous system, whereas the invention of Claims 1-20, 22-31 and 33-40 relates to a non-aqueous composition in a non-aqueous system, formulated to be applied to a substrate by spray application with an effective foam-reducing quantity of the reaction product.

For a reference to anticipate, each element of the claim must be present. Since Wiggins fails to disclose the non-aqueous composition in a non-aqueous system with an effective foam-reducing quantity of the reaction product, Wiggins does not anticipate the subject matter of the above claims, and the rejection should be withdrawn. Reconsideration and withdrawal of the rejection is respectfully requested.

#### Rejection under 35 U.S.C. § 103(a)

Claims 21 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiggins. The arguments made above with regard to the inapplicability of Wiggins

under 35 U.S.C. §§ 102(a) or (e) are reasserted herein as if set forth at length. In addition, the Assignee owns the entire interest (100 percent) in Wiggins and the present application. The entire interest in the applications was owned or under obligation of assignment to the Assignee at the time the invention was made. Accordingly, Wiggins is disqualified as prior art in any rejection under 35 U.S.C. § 103(a).

Wiggins fails to disclose a non-aqueous composition in a non-aqueous system with an effective foam-reducing quantity of the reaction product as claimed. Therefore, regardless of the number of EO groups present, there is no teaching, suggestion or motivation provided to reach the invention as claimed.

In view of the above, it would not have been obvious to use a compound with 4 EO groups as alleged to arrive at the invention as claimed, and the rejection should be withdrawn. Reconsideration and withdrawal of the rejection is respectfully requested.

Double Patenting Rejections/Rejection under 35 U.S.C. § 103(a)

Claims 1-41 were rejected as being unpatentable over Claims 1-5 and 10 of U.S. Patent No. 6,583,185 (Wiggins II) on the ground of non-statutory obviousness-type double patenting, and under 35 U.S.C. § 103(a) for the same reasons. Claims 1-43 were rejected as being unpatentable over Claims 1-20 and 22 of U.S. Patent No. 6,572,691 (Brown) on the ground of non-statutory obviousness-type double patenting.

Wiggins II relates to defoamers for aqueous systems. The reaction products of Wiggins II are added to aqueous systems, for example, latexes and latex paint. The water-insoluble liquid carrier in Claim 1 of Wiggins II is part of the composition, but is not incorporated into a non-aqueous system as claimed.

Although Wiggins II appears to disclose a non-aqueous composition, the composition is incorporated into an aqueous system, whereas the invention of Claims 1-31 and 33-41 relates to a non-aqueous composition in a non-aqueous system, formulated to be applied to a substrate by spray application with an effective foam-

reducing quantity of the reaction product. Wiggins II fails to disclose a non-aqueous composition in a non-aqueous system with an effective foam-reducing quantity of the reaction product as claimed. Therefore, regardless of the number of EO groups present, there is no teaching, suggestion or motivation provided to reach the invention as claimed.

In view of the above, it would not have been obvious to use a compound with 4 EO groups as alleged to arrive at the invention as claimed, and the rejection should be withdrawn. Reconsideration and withdrawal of the rejections is respectfully requested.

Brown relates to ink compositions and methods of use therefor. The ink compositions include a liquid vehicle and a reaction product. Brown fails to disclose a non-aqueous composition in a non-aqueous system with an effective foam-reducing quantity of the reaction product as claimed. Therefore, regardless of the number of EO groups present, there is no teaching, suggestion or motivation provided to reach the invention as claimed.

In view of the above, the subject matter of Claims 1-43 is not rendered obvious and Claims 42-43 are not anticipated in view of Brown. In view of the lack of disclosure, teaching, suggestion or motivation from Brown, the rejection should be withdrawn. Reconsideration and withdrawal of the rejection are respectfully requested.

#### Advisory Action

In the Advisory Action, the Examiner indicated that the amendments to the claims raise new issues, but did not enter the amendments. Therefore, to continue prosecution, an RCE is filed herewith.

#### Fees

A Petition for a One-Month Extension of Time is enclosed. No additional fees are believed due, but the Commissioner is authorized to charge or credit any balance of

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fees deemed due or owing to Deposit Account No. 50-1177.

**Conclusion**

It is respectfully submitted that Claims 1-32 and 35-43 are in condition for allowance. A Notice of Allowance is respectfully requested. If anything further is needed to advance the allowance of this application, the Examiner is urged to contact Applicants' attorney at the telephone number indicated below.

Respectfully submitted,

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